



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Odom, *et al.* Docket No.: FEX001
Filed: March 29, 2001 Examiner: O'Connor, Gerald J.
Serial No.: 09/821,441 Art Unit: 3627
For: Method and Apparatus for Electronic Commerce Services at a Point of Sale

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

Dear Sir:

Appellant is submitting the enclosed Revised Appeal Brief in compliance with the Notification of Non-Compliant Brief (37 CFR 41.37) mailed on March 18, 2005.

Commissioner is hereby authorized to charge any fees, or credit any overpayments, in connection with the filing of this paper, including extension of time fees, to the Deposit Account No. 50-1065.

August 18, 2005

Respectfully submitted,

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REVISED APPEAL BRIEF

Dear Sir:

This Revised Appeal Brief is respectfully submitted in connection with the above-identified application in response to the Final Rejection mailed September 21, 2004 and further in response to the Notification of Non-Compliant Appeal Brief (37 C.F.R. 41.37) mailed on March 18, 2005. A Notice of Appeal was filed by facsimile on December 20, 2004.

REAL PARTY OF INTEREST (37 C.F.R. 41.37(c)(1)(i))

The present application is assigned to GSC Enterprises, Inc.

RELATED APPEALS AND INTERFERENCES (37 C.F.R. 41.37(c)(1)(ii))

Appellant is not aware of any related appeals or interferences.

STATUS OF CLAIMS (37 C.F.R. 41.37(c)(1)(iii))

Claims 7-13 stand finally rejected. No claims have been allowed. Claims 1-6 and 14-33 are cancelled. Claims 7-13 are the subject of this appeal. The claims on appeal are reproduced in the attached Appendix.

STATUS OF AMENDMENTS (37 C.F.R. 41.37(c)(1)(iv))

An Amendment under 37 CFR §1.116 was entered after final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER (37 C.F.R. 41.37(c)(1)(v))

Claim 7:

The invention of claim 7 relates to a method for conducting financial transactions such as in-person bill payments (e.g., paying a utility bill) at a point of sale (“POS”) (e.g., a convenience store). Application, *page 3, lines 26-27*. While POS terminals are known, conventional POS terminals are prone to error in the acquisition of transaction data. When an error is subsequently detected, the original bill must be retrieved and compared against the stored transaction data to determine the source of the error. Significant costs are incurred in storing the transaction documents for a long period of time and significant personnel time can be taken up in the retrieval process. *Page 2, line 19 through page 3, line 5*. Appellant’s invention provides for a system that, e.g., (i) electronically stores an image of the bill (or other transaction documents, such as a check or the like) along with an image identifier, (ii) electronically stores transaction data relating to transaction along with a transaction identifier, and (iii) that links the image identifier to the transaction identifier. *Page 4, lines 16-28*. In this way, the stored image of the transaction documents can be readily and efficiently accessed for subsequent verification and validation of the

transaction data. *Page 5, lines 21-25.* The invention effectively eliminates the cost and effort involved in storing and retrieving large volumes of paper documents.

Figure 1 illustrates an exemplary system, which includes a point of sale (POS) terminal 2 located at a retail location, such as a convenience store, grocery store, and the like. POS terminal 2 communicates with a base computer system 4 by way of communication link 6. *Page 6, lines 15-24.* Base computer system 4 handles incoming transactions from POS terminal 2 and responds to those transactions with authorization information, verification information, acknowledgement codes, and the like. *Page 7, lines 26-31.* Base computer system 4 also communicates with an image server 16 over a communication link 20. *Page 8, lines 24- 30.* In other embodiments, POS terminal 2 may communicate directly with image server 16. *Page 21, lines 25-29.* Image server 16 includes an image database 18 that stores images of transaction documents that are processed at POS terminal 2. *Id.*

An exemplary POS terminal is illustrated in Figure 2 and includes various hardware components for handling a bill payment transaction, such as a bar code reader 54 (Figure 2), a magnetic card reader 63b, a Magnetic Ink Character Recognition (MICR) reader 54, a keypad 62, a scanner 48, and the like. *Page 9, lines 9-27.* Scanner 48 is used to create an electronic image of a document related to the financial transaction (such as a bill that is presented for payment or a check that is used for payment check) as it passes through the POS terminal, which image is stored in an image memory 50. *Id.; Page 8, lines 26-30.* A unique identifier is assigned to each image stored to the memory. *Page 12, lines 16-25.* The scanner also includes Optical Character Recognition circuitry 52, which, upon scanning the document, converts the image into electronic information about the pending transaction. *Page 11, lines 6-25.*

In operation, transaction information, regarding a pending financial transaction is obtained either via scanning the bill or by a store clerk manually inputting some or all transaction data. *Page*

12, line 26 through page 13, line 3. A unique transaction identifier is associated with the particular transaction. Page 13, lines 29-31. Additionally, as discussed above, the image of the document that has been stored in image memory is given a unique identifier and the unique image identifier is linked to the unique transaction identifier. Page 12, lines 16-25. The images are then transmitted to an image server 16 for archival in image database 18. Page 21, line 25 through page 22, line 5. Various other features of the invention are not necessary for an understanding of the issues on appeal and hence are not presented herein.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R. 41.37(c)(1)(vi))

(1) *Claims 7-10, 12 and 13 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,473,143 to Vak, et al. ("Vak").*

(2) *Claim 11 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Vak in view of U.S. Patent No. 5,652,802 to Graves, et al. ("Graves").*

ARGUMENT (37 C.F.R. 41.37(c)(1)(vii))

It is respectfully submitted that claims 7-10 and 12-13 recite patentable subject matter under the provisions of 35 U.S.C. § 102 and further that claim 11 recites patentable subject matter under the provisions of 35 U.S.C. § 103.

Rejection Under 37 C.F.R. 102(B) Over U.S. Patent No. 5,473,143 to Vak, et al. ("Vak")

Claims 7, 9-10, 12 and 13:

The Examiner finally rejected claims 7-10 and 12-13 under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,473,143 to Vak ("Vak"). To save space, these rejections will not

be repeated here. Relevant aspects of the rejections will be discussed in the Appellant's arguments.

Three primary arguments are presented herein.

Argument 1:

Claim 7 requires “transmitting to an image server a copy of [an] electronic image” along with an image identifier and a linked transaction identifier. One exemplary embodiment of this claim element is when an electronic image is transmitted from image memory 50 of POS terminal 2 (Figure 2) an image database 18 of an image server 16 (Figure 2) via a base computer system 4, and as described at *page 21, line 25 through page 22, line 5*.

Examiner has asserted¹, without further elaboration, that Vak discloses “transmitting to an image server 120 a copy of each electronic image.” Vak does not disclose an “image server,” however (a copy of Vak is included in the Evidence Appendix). Reference to Figure 2 of Vak illustrates that element 120 of Vak is a microprocessor, which is simply a component (comprising a CPU, a memory, an input, and an output, and arithmetic logic unit of a point of sale (POS) terminal 22. Examiner has nowhere identified, and Appellant is unaware of, any teaching or even suggestion in Vak as to how the microprocessor 120 of the POS terminal 22 acts as a server.

“Server” and “microprocessor” are well known terms in the relevant field and have commonly accepted meanings. A server is generally recognized as a computer that makes services, such as access to data files, programs, and peripheral devices, available to workstations on a network. By contrast, a microprocessor generally describes an integrated computer circuit that performs all the functions of a CPU [Central Processing Unit]. *Id* In short, while a server, such as the image server of Claim 7, will typically include one or more microprocessors, a microprocessor is not a server.

¹ See Final Office Action dated September 21, 2004, pg. 3.

Examiner's assertion that Vak discloses an image server simply because the reference discloses a microprocessor is akin to arguing that a reference discloses a fire truck simply because the reference discloses an engine. While it is true a fire truck includes an engine, nothing in the disclosure of an engine alone would teach or suggest all the features of a fire engine. Likewise, nothing in Vak's disclosure of a microprocessor teaches all the features of a server, as that term is commonly understood. In short, Vak discloses a microprocessor 120; it does not disclose an image server.

As Vak's Figure 2 illustrates, the microprocessor 120 of Vak is a component of a Point of Sale terminal 22. Examiner has made no assertion that the POS terminal 22 is a server (and indeed nothing in Vak would support such an interpretation). Returning to the previous analogy, Examiner's assertion is more akin to arguing when a reference teaches using an engine in a moving van (i.e., using a microprocessor in a POS terminal) then that referenced discloses a fire truck (i.e., an image server which happens to also include a microprocessor). Such reasoning is flawed.

Even assuming, solely for the sake of argument, that POS terminal 12 of Vak (which includes microprocessor 120) is a "server," nowhere does Vak teach or suggest the method step of "transmitting to" the POS terminal a "copy of each electronic image and the image identifier and linked transaction identifier" required by claim 7. The electronic images of Vak are generated *within* POS terminal 12 (in camera 184) and hence are not "transmitted to" the terminal. See Figure 2 of Vak and *Column 10, line 66 through Column 11, line 4*.

For at least these reasons, Examiner's assertion that Vak discloses "transmitting to an image server a copy of each electronic image and the image identifier and linked transaction identifier" is incorrect.

Argument 2:

Claim 7 requires storing each electronic image to memory with “an image identifier.” Examiner has apparently conceded that Vak does not expressly disclose this element because Examiner had asserted that this element is “inherent, as the system [of Vak] ‘knows’ where the image is stored.”² Examiner’s assertion requires a leap of faith that knowing the location of an item in memory is the same as associating an identifier with that item. This is not correct, however, as a careful reading of Vak reveals. The element of Vak that Examiner has asserted is an image memory is in fact an “input buffer” 174 for the camera 184. See Vak, *Figure 3; Column 10, line 58 through Column 11, line 4*. Examiner has provided no rationale as to why an image stored in an input buffer – which is a known physical location – would require an image identifier in order for the system to “know” where the image is.³ Appellant respectfully submits that the reason Vak provides no teaching of storing an image identifier along with the image is because no such image identifier is needed when the image is placed in a known physical location, i.e., the input buffer 174.

Argument 3:

Claim 7 requires storing each electronic image in memory “with an image identifier and linking the image identifier to a transaction identifier.” Examiner has asserted that this element is inherent in Vak, as the system “knows . . . to which transaction the image pertains.”⁴ As expressed in the preceding section, however, Vak does not teach or suggest storing an image identifier. As such, Vak can hardly teach linking a (non-existent) image identifier with a transaction identifier.

² See Final Office Action dated September 21, 2004, pg. 3.

³ Appellant recognizes that an input buffer may have a “logical address” associated with it, as well as a physical location. Even assuming this to be the case, the logical address of a physical location is fundamentally different than, e.g., a file name or other identifier of the image stored at that physical location.

Appellant traverses Examiner's rejection for another reason. Examiner wrongly assumes that the system of Vak must inherently "know" to which transaction the image pertains. Why is this so? As Vak clearly teaches, the scanned image of Vak "will be placed in the input buffer 174 and further analysis and processing will occur according to normal OCR processing capabilities of the terminal." Vak, *Column 10, line 66 through Column 11, line 4*. In other words, Vak uses the electronic image for OCR processing. There is no teaching or even a remote suggestion in Vak that the electronic image will be stored for subsequent retrieval or use. As such, there is no reason for the system of VAK to "know" to what transaction the image relates. Appellant respectfully submits that Examiner has viewed Vak through the looking glass of Appellant's own disclosure in order to find teachings that are not contained in that reference. It is improper, however, to impose the teaching of Appellant's own disclosure to read into the prior art elements that simply are not there.

Claim 8:

In addition to the above points raised with regard to claim 7, from which claim 8 depends and which are incorporated herein by reference, Appellant argues the following points specifically to claim 8.

Claim 8, which depends from claim 7, recites "storing the transmitted transaction data in a transaction database." Examiner has asserted that this claim limitation is met in element 232 of Vak.⁵ A close reading of Vak, however, reveals that element 232, far from being a transaction database, is merely an element of "a flow chart of the computer program." Vak, *Figure 3; Column 13, lines 44-60*. Although element 232 is described as a "log transaction for recovery function," it is clearly not in any way a database, but rather "a standard function executed by institution

⁴ See Final Office Action dated September 21, 2004, pg. 3

⁵ See Final Office Action dated September 21, 2004, pg. 3.

processor 18 or 36.” While the function being illustrated by block 232 has the phrase “transaction” associated with it, nowhere does the reference teach or remotely suggest that the function is a “database.”

While Appellant recognizes that a “database” in addition to memory storage is instantiated as routines and instructions performed by a microprocessor, nothing in Vak teaches or suggests that the “computer program” running on Vak’s microprocessor is a database program. Again, Examiner has impermissibly relied upon Appellant’s own disclosure to assume such a feature is in the prior art.

Claim 8 also recites storing the transmitted electronic image in an image database. Vak does not disclose an image database. Rather, Examiner identifies memory 126 of Figure 2 as disclosing this element.⁶ With regard to this element, Vak states nothing more than, “The CPU 124 of the microprocessor 120 also fetches data from and stores data into a memory 126.” Vak, *Column 9, lines 47-52*. The reference does not teach or suggest configuring the memory as a database and the reference does not teach or suggest storing images in the memory. Appellant respectfully submits that nothing in Vak supports Examiner’s assertion that memory 126 is an image database.

Rejection Under 35 U.S.C. 103 (A) Over U.S. Patent No. 5,473,143 to Vak, et al. in View of U.S. Patent 5,657,802 to Graves, et al.

Claim 11:

Claim 11 requires generating transaction information through optical character recognition (“OCR”) by “comparing the electronic image to a pre-stored template containing an expected

⁶ See Final Office Action dated September 21, 2004, pg. 3.

electronic image.” The pre-stored template informs the OCR system where transaction data is to be found in the scanned image and what type of data is to be found there. Application, *Page 11, lines 5-30*. Using the pre-stored template, the OCR system converts the information from the scanned image into transaction information, which can be stored, analyzed, and manipulated electronically. *Id.* Examiner concedes that Vak fails to disclose this feature.⁷ Examiner asserts, however, that U.S. Patent No. 5,652,802 to Graves, *et al.* (“Graves”) overcomes this deficiency in the primary reference (a copy of Graves is included in the Evidence Appendix). Appellant traverses Examiner’s position because Graves nowhere discloses optical character recognition. At best, Graves teaches a system wherein a scanned pattern is compared to a pre-stored master pattern. While Graves does provide the use of a pre-stored pattern, it nowhere teaches or suggests that transaction data could be generated by comparing a scanned document to the pattern. This is because Graves is not concerned with, and does not teach, optical character recognition. In fact, there is no motivation to modify Graves to provide for OCR, because Graves is merely concerned with determining whether a scanned document is or is not legal tender. *See Graves’ Abstract*. In other words, Graves is not concerned with the data contained in the scanned image. Rather, Graves is concerned with simply ensuring that the scanned image matches the pre-stored pattern. It is only with the benefit of improper hindsight that one would be motivated to modify Graves to provide for generating transaction data using OCR by comparing a scanned document to a template.

⁷ See Final Office Action dated September 21, 2004, pg. 4.

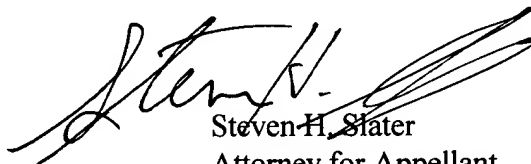
CONCLUSION

For the foregoing reasons, Appellant respectfully submits that the Examiner's final rejection of claims 7-10, and 12-13 under 35 U.S.C. § 102 and final rejection of claim 11 under 35 U.S.C. § 103 is improper and respectfully requests that the Board of Patent Appeals and Interference so find and reverse the Examiner's rejections.

To the extent necessary, Appellant petitions for an Extension of Time under 37 C.F.R. § 1.136. Please charge any fees, or credit any overpayments, in connection with the filing of this paper, including extension of time fees, to the Deposit Account No. 50-1065.

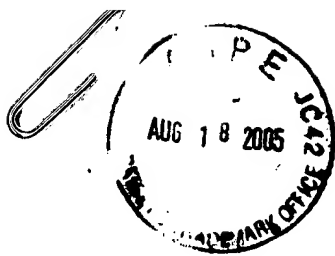
August 18, 2005

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Steven H. Slater", written over a horizontal line.

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CLAIMS APPENDIX

APPEALED CLAIMS

7. A method for processing an in-person bill payment at a point of sale location, comprising:

identifying a biller for whom payment of a payment transaction is to be received;

obtaining transaction information concerning the payment;

receiving payment for the bill;

assigning a transaction identifier to the transaction;

scanning at least one transaction document and generating at least one electronic image
therefrom;

storing each electronic image in an image memory with an image identifier and linking the
image identifier to a transaction identifier;

transmitting the transaction information to a payment server;

receiving from the payment server instructions regarding the transaction; and

transmitting to an image server a copy of each electronic image and the image identifier and
linked transaction identifier.
8. The method of claim 7 further comprising:

storing the transmitted transaction information in a transaction database;

storing the transmitted electronic image and identifiers in an image database; and

forwarding selected transaction information to the biller and forwarding at least a portion of
the received payment to the biller.

9. The method of claim 7 further comprising:
detecting magnetically stored information located on the at least one transaction document
and converting the magnetically stored information into electronic transaction information.
10. The method of claim 7 further comprising generating transaction information from said
electronic image through optical character recognition.
11. The method of claim 10 wherein the transaction information is generated by comparing the
electronic image to a pre-stored template containing an expected electronic image.
12. The method of claim 7 further comprising receiving from the payment server additional
system update instructions.
13. The method of claim 12 wherein said system update instructions comprise a list of billers
for whom in-person bill payment is authorized.

EVIDENCE APPENDIX

Included in this Appendix is:

A copy of U.S. Patent No. 5,473,143 to Vak, *et al.* (*relied upon by Examiner in Office Action dated March 21, 2004*)

A copy of U.S. Patent No. 5,652,802 to Graves, *et al.* (*relied upon by Examiner in Office Action dated March 21, 2004*)

RELATED PROCEEDINGS APPENDIX

None.